

REMARKS/ARGUMENTS

Claims 1 and 61 have been amended to recite that the composition is an emulsion. Support for these amendments can be found, throughout the specification including, for example, in paragraphs 0028 and 0029, in Example 1 (¶ 0150), and in original claims 1, 61, 42, and 43.

Claim 43 has been amended to depend from claim 1. In view of the amendment to claim 1, claim 43 has also been amended for clarity to remove redundant language. Support for this amendment can be found throughout the specification including, for example, in paragraphs 0028 and 0029, in Example 1 (¶ 0150), and in original claims 1, 42, and 43.

Claim 44 has been canceled without prejudice.

Applicant submits that no new matter has been added via these amendments to the claims.

35 U.S.C. § 112, Second Paragraph

Claim 43 has been rejected as indefinite. In the view of the Patent Office, the claim is indefinite for being "dependent upon a cancelled claim." (Paper No. 20080620 at 2.) Claim 43 has been amended to depend from claim 1. Accordingly, the rejection has been rendered moot. Withdrawal of the rejection is respectfully requested.

Claim 44 has been rejected as indefinite. In the view of the Patent Office, the claim is indefinite because it recites that the cosmetic composition is anhydrous, but depends from claim 1, which recites that the composition includes an aqueous phase. (Paper No. 20080620 at 3.) Claim 44 has been canceled without prejudice. Accordingly, the rejection has been rendered moot. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103

Claims 1-4, 6, 12, 15, 20-29, 31, 34-35, 38-41, and 43-64 have been rejected under 35 U.S.C. § 103(a) as

unpatentable over Caes, et al., WO 00/49997 ("Caes") in view of Kashiwara, et al., WO 02/092470 ("Kashiwara"). (Paper No. 20080620 at 3-4.) The Examiner has alleged that Caes teaches "'transfer-free composition[s] comprising (a) at least one of di-block, tri-block, multi-block and/or radial block copolymer and optionally (b) a film former or mixture of film formers. . . ." (Id. at 4.) The Examiner has also alleged that Caes teaches that the block copolymer may be a Kraton® rubber and may be dissolved in a hydrocarbon solvent, such as isododecane. (Id. at 4-5.) The Examiner has acknowledged that Caes differs from the claimed invention in that it does not teach "a composition comprising silicone elastomer powder as the cosmetic powder." (Id. at 6.) To fill this gap, the Examiner has alleged that Kashiwara "teaches a cosmetic composition comprising silicone elastomer powder, water soluble polymer, water soluble humectant, a nonvolatile silicone compound and an aqueous carrier." (Id.) The Examiner has determined that "it would have been obvious . . . to combine [Kashiwara] with [Caes] to improve the cosmetic of" Caes. (Id. at 7.)

Kashiwara explicitly teaches that its cosmetic compositions are in "a non-emulsified form." (Abstract and p. 14, lines 23-35.) The claimed invention is an emulsion. Thus, to arrive at the claimed invention, would have required ignoring explicit teachings in Kashiwara. One of skill in the art would have had no rationale to do so. Accordingly, the cited prior art does not provide a basis for a *prima facie* case for the obviousness of the claimed invention.

Claims 1 and 61, from which the remaining rejected claims depend, have been amended to recite that the "composition is an emulsion." In contrast, Kashiwara teaches that:

The compositions of the present invention have an aqueous continuous phase, and are in a non-emulsified form. It is believed that such product form is advantageous in delivering the water soluble components

such as water soluble humectants and optional tacky skin treatment agents, as well as the solid silicone elastomer powder. Without being bound by theory, it is also believed that the inclusion of surfactant for making an emulsion, for example an oil-in-water emulsion, affects the wear resistance of the composition. Foundation bases should not affect the performance and stability of the foundation to be applied on top of it. Foundations bases that do not have a certain degree of wear resistance will mingle with the foundation, when the foundation is applied on the skin. Emulsions have a higher tendency to wet the foundation and alter its color, or affect the stability of the foundation when mingled with the foundation.

(P. 14, lines 23-35 (emphasis added).) Thus, *Kashihara's* contribution to the field is "an aqueous cosmetic composition which . . . is suitable as a foundation base product." (P. 2, lines 15-19.)

To arrive at the claimed invention, would have required one of skill in the art to ignore the teaching of *Kashihara* that emulsions are not suitable as its foundation bases. However, prior art publications must be evaluated in their entirety. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. See, *In re Mercer* 515, F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (C.C.P.A. 1975). This is particularly true when a reference teaches away from the claimed invention, as *Kashihara* does. *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1381, 83 U.S.P.Q.2d 1746, 1751 (Fed. Cir. 2007) (a "reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant.").

In essence, to arrive at the claimed invention, one of ordinary skill in the art would have had to dismantle

Kashihara's invention and import only its silicone elastomer powder into an emulsion composition of *Caes*, while ignoring the teaching of a foundation base composition in a non-emulsified form. However, the routineer in the art is an objective legal construct, who is presumed to think along conventional lines, without undertaking to innovate, whether by systematic research or by extraordinary insights. See *Life Technologies Inc. v. Clontech Lab, Inc.*, 224 F.3d 1320, 1325, 56 U.S.P.Q.2d 1186, 1190 (Fed. Cir. 2000) (quoting *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 U.S.P.Q. 293, 297 (Fed. Cir. 1985)). Accordingly, one of skill in the art would have had no rationale to modify the compositions of *Caes* with the silicone elastomer powders of *Kashihara* (while ignoring the other teachings of *Kashihara*) as required to arrive at the claimed invention. Withdrawal of the rejection is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/816,574

Docket No.: LOREAL 3.0-038

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 4, 2009

Respectfully submitted,

By 

Stephen J. Brown

Registration No.: 43,519
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

LD-446\895754_1.DOC